

REMARKS/ARGUMENTS

This paper is submitted in response to the Office Action mailed September 6, 2006. Reconsideration is respectfully requested.

Claims 3-10 were examined. Claim 3 was rejected under 35 U.S.C. §103(a) as unpatentable over US 5,662,671 – Barbut et al. in view of US 5,439,446 – Barry. Claims 4-10 were held to define allowable subject matter, but were objected as depending from a rejected base claim.

For the reasons set forth below, the rejection under 35 U.S.C. §103(a) is respectfully traversed.

DISQUALIFICATION OF REFERENCE UNDER 35 U.S.C. §103(c)

Barbut et al. '671 issued on September 2, 1997 from an application filed July 17, 1996. The subject application has an effective filing date at least as early as May 12, 1997. Barbut et al. '671 is therefore available as a reference only under 35 U.S.C. §102(e). The subject application and the Barbut et al. '671 patent were, at the time the invention claimed herein was made, owned by or subject to an obligation of assignment to, the same entity (i.e., Embol-X, Inc.). Accordingly, Barbut et al. '671 is disqualified as a reference against the invention claimed herein under 35 U.S.C. §103(c).

DISCUSSION OF AMENDED CLAIMS

With the disqualification of Barbut '671, claim 3 is allowable. This claim has been amended solely for the purpose of better clarity, i.e., to clarify that the filter and the occluder are both expandable and contractable in accordance with the claimed method, and to clarify that the embolic material that is removed is captured by the contracted filter. It is believed that these amendments do not materially affect the scope of the claim.

Claims 4, 5, and 8-10 have been amended to correct their dependency so that they now properly depend from claim 3, instead of cancelled claim 2.

New claims 11-14 are submitted to present claims directed to the novel and non-obvious use of a filter with an inflatable inflation seal, as defined in (now cancelled) claim 6. Claim 7 has been amended to depend from claim 12, so as to provide a proper antecedent basis for the term “pressurizing cannula.” New claims 15 and 16 are submitted to present

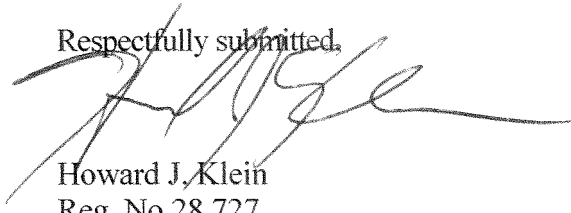
claims directed to the allowable subject matter of claim 9, and new claims 17 and 18 are submitted to present claims directed to the allowable subject matter of claim 10.

In summary, it is respectfully submitted that claims 3-5 and 7-18 are now allowable over the non-disqualified art of record. Passage of the application to issue is therefore earnestly solicited.

Should there be any further issues to be resolved in the application, the Examiner is respectfully requested to telephone the undersigned attorney to expedite the prosecution of the application to issue.

Date: November 29, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read "H. Klein", is written over the typed name and address.

Howard J. Klein
Reg. No.28,727
Klein, O'Neill and Singh, LLP
43 Corporate Park Drive
Suite 204
Irvine, California 92606